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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/672,130
Filing Date: September 26, 2003
Appellant(s): RAMIREZ ET AL.

MAILED

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GROUP 3600

DELL PRODUCTS L.P.
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 August 2006 appealing from the

Office action mailed 07 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The summary of claimed subject matter contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,009,401   HORSTMANN   12-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Status of Claims

Claims *1-11* and *13-20* have been examined.

Claim Rejections - 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims *1-11* and *13-20* are rejected under 35 U.S.C. §102(b) as being

anticipated by *Horstmann, U.S. Patent No. 6009401*, published on *28 December 1999*.

As per **claim 1**, Horstmann discloses a method for enabling remote restoration of

a purchase verification, comprising:

- obtaining a value that uniquely identifies an information handling system *(i.e.,
  'machine ID', a unique identification of the end-user machine – see column 5 lines
  6-7, 10)*;

- obtaining a promotion code value that identifies a benefit *(i.e., obtaining/retrieving
  a license certificate [identified by license number] that identifies/describes license
  terms, policies, info. for re-licensing, server locations, etc. – see col. 3 lines 12-17)*;

- linking the value that uniquely identifies the information handling system with the
  promotion code value for the information handling system *(i.e., the re-licensing
  manager sends a request for the re-installation of the software along with the unique*

'machine ID', a unique identification of the end-user machine on which the software and license certificate reside, to the clearing house server – see col. 5 lines 4-7);

- during remote restoration, obtaining the promotion code value for the information handling system by providing the value that uniquely identifies the information handling system *(i.e., the re-licensing manager provides the 'machine ID' to the clearing house server ... and retrieves/obtains the license certificate if a matching purchase record can be found – see col. 2 lines 62-63, col. 4 lines 6-11, col. 5 lines 4-10 and 12-16)*;

- providing the promotion code value to the information handling system to re-enable the benefit *(i.e., providing the license certificate to the requested end-user machine for re-licensing and download of the software – see col. 4 lines 6-34, col. 5 lines 3-16)*;

- installing application software in an information handling system memory when the information handling system is assembled at a manufacturing facility *(col. 4 lines 25-34)*; and

- linking any promotion code values with the value that uniquely identifies the information handling system within an order management system *(i.e., the re-licensing manager ... re-installing and updating the license certificate on the requested end-user machine – see col. 4 lines 10-11 and 31-34)*.

As per **claims 3, 8, 13, 18**, Horstmann discloses the method/system of claims 1, 7, 11, and 17, respectively, wherein:

- the promotion code value includes a system-specific key that enables a benefit *(i.e., the license certificate/ticket includes a 'machine ID' [which specifically and uniquely identifies the requested end-user machine] that allows/authorizes [i.e., enables] for the re-installation and re-licensing of the previously installed software [i.e., a benefit] for the requested end-user machine – see col. 4 lines 10-34, col. 5 lines 4-16).*

As per **claims 4 and 14**, Horstmann discloses the method/system of claims 3 and 13, respectively, wherein:

- the benefit was erased prior to registration of the benefit *(i.e., in the event the machine hard drive fails, the license certificate [that enables the benefit] ... need to be re-installed. Thus, it is understood that the old license terms & policies stored in the old license certificate was automatically wiped out [i.e., the benefit was erased ...] just prior to the re-installation/registration of the license certificate & software itself – see col. 3 lines 63-65, col. 4 lines 10-34);* and

- the method includes placing the keys and software back onto the information handling system *(i.e., re-installing the license certificate/ticket [that includes the 'machine ID', i.e., keys] and the software itself onto the requested end-user machine – see col. 4., lines 10-34, col. 5 lines 3-16).*

As per **claims 5, 9, 15, and 19**, Horstmann discloses the method/system of claims 1, 7, 11, and 17, respectively, wherein:

- the value that uniquely identifies the information handling system is a service tag *(i.e., a purchase document such as a license certificate or a sales receipt with a*

unique license number that can be used to retrieve the electronic license that allows

for convenient re-download and re-licensing of the software [i.e., a service tag] – see

col. 2 lines 61-63, col. 3 lines 12-17, col. 5 lines 33-37; or 'the clearinghouse returns

a "ticket", containing a ticket serial number, the name of the software whose

download is authorized and the 'machine ID' that is authorized to receive the

download [i.e., a service tag] ... -- col. 5 lines 3-16).

As per **claims 6, 10, and 20**, Horstmann discloses the method/system of claims

1, 7, and 17, respectively, further comprising:

- determining whether any promotion code value or benefit is present on the

  information handling system during the remote restoration *(i.e., the re-licensing*

  manager first checks the re-licensing policies as stored within the license terms

  portion of the license certificate stored on the end-user's machine – see col. 4 lines

  14-16); and

- comparing an expected promotion code value and expected benefit to any

  promotion code value or benefit stored on the information handling system to

  determine which promotion code value and benefit to restore to the

  information handling system *(i.e., the clearing house server checks the license*

  certificate database for the particular license certificate & compares for its terms,

  policies, permission with re-licensing, etc. – col. 4 lines 12-25).

As per **claim 7**, Horstmann discloses a process for remote creation of a system-

specific key for a benefit purchased post point-of-sale from a manufacturer of an

information handling system comprising:

- obtaining a value that uniquely identifies the information handling system, the value that uniquely identifies the information handling system being installed on the information handling system when the information handling system is fabricated *(i.e., 'machine ID', a unique identification of the end-user machine – see col. 5 lines 6-7, 10)*;

- obtaining a promotion code value that identifies the benefit *(i.e., obtaining/retrieving a license certificate [identified by license number], i.e., promotion code value, that identifies/describes license terms, policies, info. for re-licensing, server locations, etc. [i.e., the benefit] – see col. 3 lines 12-17)*;

- linking the value that uniquely identifies the information handling system with the product code value *(i.e., linking the 'machine ID' [that uniquely identifies the information handling system] with the ticket serial number contained in the ticket that identifies the name [along with the ID/code that uniquely identifies the authorized software to be downloaded] of the authorized software to be downloaded – see col. 5 lines 3-12)*; and

- creating the system-specific key for the benefit purchased post point-of-sale based upon the value that uniquely identifies the information handling system *(i.e., the clearing house server creates/returns a 'ticket' [that includes a 'ticket serial number', the name/code/ID of the software whose download is authorized, and 'the machine ID' that is authorized to receive the software download, etc.], [i.e., a system-specific key], that allows/authorizes the re-licensing of the software [i.e., the benefit purchased post point-of-sale] for the particular, requested end-user machine*

[i.e., based on the value that uniquely identifies the information handling system] –

*see **col. 5 lines 3-12***; and

• providing the promotion code value to the information handling system to enable

the benefit *(i.e., providing the **license certificate** [i.e., promotion code value] to the*

*requested end-user machine for enabling **the re-licensing and download of the***

*software [i.e., the benefit] – see **col. 4 lines 6-34***).

As per **claim 11**, Horstmann discloses a system for enabling remote restoration

of a purchase verification, comprising:

• *a restore module (i.e., a re-licensing manager – see **col. 3 line 12, col. 4 lines 6-34**)*,

the restore module being configured to:

❖ obtain a value that uniquely identifies an information handling system *(i.e.,*

*machine ID, a unique identification of the end-user machine – see **col. 5 lines***

6-7, 10);

❖ obtain a promotion code value that identifies a benefit *(i.e.,*

obtaining/retrieving a license certificate [identified by license number] that

identifies/describes license terms, policies, info. for re-licensing, server

*locations, etc. – see **col. 3 lines 12-17**)*;

❖ link the value that uniquely identifies an information handling system with

the product code value for the information handling system *(i.e., linking*

the 'machine ID' with the ticket serial number contained in the ticket that

*identifies the name of the authorized software to be downloaded – **col. 5 lines***

7-12);

❖ during remote restoration, obtain the promotion code value for the

information handling system by providing the value that uniquely

identifies the information handling system *(i.e., the re-licensing manager*

provides the 'machine ID' to the clearing house server ... and retrieves/obtains

the license certificate if a matching purchase record can be found – see col. 4

lines 6-11, col. 5 line 10); and,

❖ provide the promotion code value to the information handling system to re-

enable the benefit *(i.e., providing the license certificate to the requested end-*

user machine for enabling the re-licensing and download of the software – see

col. 4 lines 6-34);

• *an install module*, the install module installing application software on an

information handling system memory when the information handling system is

assembled at a manufacturing facility *(i.e., a re-licensing manager – see col. 3*

line 12, col. 4 lines 6-11, 21-34); and

• *a link module*, the link module linking any promotion code values with the value

that uniquely identifies the information handling system within an order

management system *(i.e., re-licensing manager, installing & linking license*

certificate with the specific, requested end-user's machine – see col. 4 lines 6-34).

As per **claim 16**, Horstmann discloses the system of claim 11 further comprising:

• *a determining module*, the determining module determining whether any

promotion code value or benefit is present on the information handling system

during the remote restoration *(i.e., the re-licensing manager first checks the re-*

licensing policies as stored within the license terms portion of the license certificate

*stored on the end-user's machine – see **col. 4 lines 14-16**)*; and

- *a comparing module*, the comparing module comparing an expected promotion

   code value and expected benefit to any promotion code value or benefit

   stored on the information handling system to determine which promotion code

   value and benefit to restore to the information handling system *(i.e., the*

   clearing house server checks the license certificate database for the particular license

   certificate & compares for its terms, policies, permission with re-licensing, etc. – col.

   4 lines 12-25).

As per **<u>claim 17</u>**, Horstmann discloses a system for remote creation of a system-

specific key for a benefit purchased post point-of-sale from a manufacturer of an

information handling system comprising:

- *a restore module (i.e., a re-licensing manager – see **col. 3 line 12, col. 4 lines 6-34**),*

   the restore module being configured to:

   ❖ obtain a value that uniquely identifies the information handling system, the

      value that uniquely identifies the information handling system being

      installed on the information handling system when the information

      handling system is fabricated *(i.e., machine ID, a unique identification of the*

      *end-user machine – see **col. 5 lines 6-7, 10**)*;

   ❖ obtain a promotion code value that identifies a benefit *(i.e.,*

      obtaining/retrieving a license certificate [identified by license number] that

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identifies/describes license terms, policies, info. for re-licensing, server

*locations, etc. – see **col. 3 lines 12-17**)*;

❖ link the value that uniquely identifies an information handling system with

the product code value for the information handling system *(i.e., linking*

the 'machine ID' with the ticket serial number contained in the ticket that

*identifies the name of the authorized software to be downloaded – **col. 5 lines***

***7-12**)*;

❖ create the system-specific key for the benefit purchased post point-of-sale

based upon the value that uniquely identifies the information handling

system *(i.e., the clearing house server creates/returns a 'ticket' that*

allows/authorizes the re-licensing of the software for the particular, requested

*end-user machine – see **col. 5 lines 7-12**)*; and

❖ provide the promotion code value to the information handling system to

enable the benefit *(i.e., providing the license certificate to the requested end-*

user machine for enabling the re-licensing and download of the software – see

***col. 4 lines 6-34**)*.

(10) Response to Arguments

Argument #1:

The appellant argues that Horstmann does not teach or suggest *"**promotion***

***code** value that identifies a benefit"*.

Response #1:

As discussed in the present application, "a '*promotion code*' provides an indicia of whether or not particular goods or services are included within a computer system, and if so, identifies the goods or services" (See e.g., the Appellant's Application, Page 3, lines 15-28). Accordingly, the prior art by Horstmann teaches a '*license certificate*' [identified by a unique '*license number*' – **col. 4 line 6, col. 5 line 35**] -- i.e., *a promotion code value*, that identifies/describes license terms and policies [such as whether or not *re-installing* {also used interchangeably with '*re-downloading*'} and *re-licensing* of software is permitted, and whether or not there is any count of a limited number of reinstallations left for the requested end-user's machine], server locations, etc. under a valid license, after the software was purchased is clearly a post-purchase *benefit* (**col. 3 lines 12-17, col. 4 lines 2-25**) (see **Appendix A**).

Argument #2:

The appellant argues that Horstmann does not teach or suggest "*a method and system for enabling **remote restoration** of a purchase*".

Response #2:

As discussed in the present application, a '*remote restoration*' occurs when it is necessary for a client to perform a software re-installation or hard drive replacement on a computer system which includes a product key (See e.g., the Appellant's Application, Page 3, line 29 – Page 4 line 3). Accordingly, the prior art by Horstmann teaches a mechanism and system that provides purchase documentation and that allows for convenient '*re-download*' {also used interchangeably with '*re-install*'} and '*re-licensing*' of software, including old software versions (software re-download/re-install: **col. 2 lines 62-63, col. 3 lines**

63-65, col. 4 line 66 – col. 5 line 16, col. 5 lines 23-27; software re-licensing: **col. 4 lines 6-25)**

(see **Appendix A**).

Argument #3:

The appellant argues that Horstmann does not teach or suggest *"obtaining a value that uniquely identifies an information handling system where the value that uniquely identifies the information handling system is installed on the information handling system when the information handling system is fabricated"*.

Response #3:

Accordingly, the prior art by Horstmann teaches the aspect of the *'machine ID'* (a.k.a. *'serial number'*), a unique identification of the end-user machine [or hardware device, e.g., computer], i.e., the information handling system (**col. 5 lines 4-16**) (see **Appendix A**) where the *'machine ID/serial number'* is embedded/installed on the machine [or hardware device] at the time the machine is fabricated/assembled at a manufacturing facility is also well-known in the art (**col. 2 lines 42-47**) (see **Appendix A**).

Argument #4:

The appellant argues that Horstmann does not teach or suggest *"linking the promotion code value with the value that uniquely identifies the information handling system"*.

Response #4:

Accordingly, the prior art by Horstmann teaches a *'license certificate'* [identified by a unique *'license number'* – **col. 4 line 6, col. 5 line 35**] -- i.e., *a promotion code value* -- *created specifically for and stored on* the end-user's machine [or hardware device] during original

installation of a software product at purchase (**col. 3 lines 12-15**) to identify or describe a post-purchase _benefit_ of re-installation/re-download and re-licensing of electronically distributed software that is often bound to a particular machine by computing a quantity known as a '_machine ID_', either from a '_serial number_' of one of the machine components that is known to be unique or from a sufficient number of machine characteristics such that the ID is statistically unique. If the software is moved to another machine, the software recognizes the change in machines and will not run/execute (**col. 2 lines 42-49**). Furthermore, in order for the re-installation/re-download and re-licensing of electronically distributed software to take place, the _promotion code value_ and the '_machine ID_' are validated/authenticated beforehand (**col. 5 lines 4-16**) (see **Appendix A**). For this reason, Horstmann clearly teaches '_linking the promotion code value with the value that uniquely identifies the information handling system_'.

Argument #5:

The appellant argues that Horstmann does not teach or suggest "a process and system for **remote creation** of a system-specific key for a benefit purchased post point-of-sale based upon the value that uniquely identifies the information handling system".

Response #5:

Accordingly, the prior art by Horstmann teaches 'when the re-licensing manager sends the request for re-installation of software to the re-licensing clearinghouse, it also **sends _a_ _unique {or statistically unique} identification of the machine_** on which it resides. The clearinghouse creates/returns a "_ticket_" containing a ticket serial number, the _name_ [along with the _product key_] of the software whose download is authorized and the _machine ID_ that is authorized to receive the download and encrypts this information with a secret key shared with

the product server' (**col. 5 lines 4-12**) (see **Appendix A**). This clearly shows that Horstmann

teach a process and system for *"remote creation of a system-specific key for a benefit purchased*

post point-of-sale based upon the value that uniquely identifies the information handling

system".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Nancy T. Le

Patent Examiner, Art Unit 3621

ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
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Vincent Millin, Supervisory Patent Examiner

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Appendix A –

Claim No.	Claim Features	Examiner's Claim Interpretation and/or **Prior Art Citation**
1	• obtaining a value that uniquely identifies an information handling system	i.e., machine ID, a unique identification of the end-user machine – see **col. 2 lines 42-47, col. 5, lines 4-16**
	• obtaining a promotion code value that identifies a benefit	i.e., obtaining/retrieving a *license certificate* [identified by license number – **col. 4 line 6, col. 5 line 35**] – i.e., a promotion code value -- that identifies/describes license terms, policies, info. for re-installation and re-licensing of software, server locations, etc. -- i.e., a benefit – see **col. 3, lines 12-17, col. 4 lines 2-25**
	• linking the value that uniquely identifies the information handling system with the promotion code value for the information handling system	i.e., the re-licensing manager sends a request for the re-installation of the software along with the unique '*machine ID*', a unique identification of the end-user machine on which the software and license certificate reside, to the clearing house server – see **col. 5, lines 4-16**
	• during **remote restoration**, obtaining the promotion code value for the information handling system by providing the value that uniquely identifies the information handling system	i.e., the re-licensing manager sends a request for the **re-installation** of the software along with the unique '*machine ID*', a unique identification of the end-user machine on which the software and license certificate reside, to the clearing house server – see **col. 2 lines 62-63, col.3 lines 63-65, col. 4 line 66 - col. 5 line 23-27**
	• providing the promotion code value to the information handling system to re-enable the benefit	i.e., providing the license certificate that contains the '*machine ID*', i.e., *promotion code*, to the requested end-user machine for re-licensing

		and download of the software – see **col. 4, lines 6-34, col. 5 lines 3-16**
	• installing application software in an information handling system memory when the information handling system is assembled at a manufacturing facility	**col. 3, lines 62-63, col. 4 lines 25-34**
	• linking any promotion code values with the value that uniquely identifies the information handling system within an order management system	i.e., the re-licensing manager ... re-installing and updating the license certificate on the requested end-user machine – see **col. 4, lines 10-11, 31-34, col. 5 lines 4-16**
17	Similar to claim 1 above with the following additional feature:	
	• creating the system-specific key for the benefit purchased post point-of-sale based upon the value that uniquely identifies the information handling system	i.e., the clearing house server creates/returns a *'ticket'* that allows/authorizes the re-licensing of the software for the particular, requested end-user machine – see **col. 5, lines 4-12**